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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,668	01/22/2004	David L. Patton	80521B/F-P	5162

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,668

Applicant(s)

PATTON, DAVID L.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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2. Claims 1 recites the limitation "the printer" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is further not understood what is meant by "a second indicia not capable of being scanned which is not visible under normal viewing conditions..."

3. Claim 3, it is not understood what is meant by "that can be seen when view under UV..." Does applicant mean to say "when viewed"?

4. Claim 7 recites the limitation "the printer" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12, 14, 18-23, 25 and 29-34 of copending Application No. 09/534,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a stamp comprising a first indicia identifying stamp as limited edition; a second and third indicia not capable of being scanned, not visible under normal viewing conditions, and using ink that can be seen when viewed under UV or infrared light; and further wherein the third indicia is used for identifying a printer and/or location of printed stamp.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gasper et al (5,919,730) in view of Ottawa Citizen.

Gasper et al discloses in Fig. 1 and 1A, a document (10, which could be considered a stamp or sheet of stamps, as stated in Col. 5, lines 46-58) comprising a visible first indicia (12) identifying document (Col. 5, lines 47-50), a second indicia (16) made using ink that can be seen when viewed under UV or infrared light (Col. 9, lines 19-24) and not visible under normal viewing conditions (Col. 6, lines 15-23).

However, Gasper et al does not disclose a stamp comprising: a second indicia that is not capable of being scanned; first indicia identifying stamp as limited edition and one out of a predetermined amount; a third indicia for identifying a printer or location where stamp was printed, wherein the third indicia is not visible to the eye under normal viewing conditions, is not capable of being scanned, and is made using ink that can be seen under UV or infrared light.

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Ottawa Citizen discloses in lines 2, 3 and 24-28, a limited edition postal stamp comprising indicia to show that the stamp or sheet of stamps is one out of a predetermined number (1,000).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gasper et al's document to be in the form of a stamp comprising indicia as taught by Ottawa Citizen for the purpose of providing a limited edition postal stamp.

In regards to **Claim 1 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desirable indicia on the document substrate, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the document substrate may render the device unique by providing an individual with a specific type of article does not alter the functional relationship. Mere support by the substrate for the printed matter (indiciums) is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any indicia on the document, since applicant has not disclosed that only using stamp indicia is critical to the invention, and invention would function equally as well if it had any type of indicia on a substrate which needs to be authenticated such as art or a photograph and autograph display.

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In regard to **Claims 1, 4-6 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many types of indicia having the same characteristics as those of a preceding indicia (second indicia) as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to place any number of indicia on the stamp substrate, since applicant has not disclosed the criticality of having a particular number, that such a modification would produce no new or unexpected results for patentability, and the invention would operate would operate equally as well with any number of indicia.

In regards to **Claims 1, 5 and 7**, wherein the second and third indicia is not capable of being scanned; and wherein the third indicia is used for identifying a printer or printing location, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the indicia (second) of the Gasper et al reference is capable of being unscannable and used for printer identification or printing location.

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Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Beasley, Patton, Brasington et al, Mikhail, St. Louis Post Dispatch, and Dlugos et al discloses similar stamps.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

June 3, 2004



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
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